

REMARKS

The Office Action dated March 4, 2010, has been received and reviewed. This response is directed to that action.

The applicants include herewith a declaration under 37 C.F.R. §1.132 in support of the patentability of the presently claimed invention.

The applicants respectfully request reconsideration in view of the enclosed declaration and the following remarks.

Objections to the Specification

The Examiner objected to the specification, and requested that the term "(in % by weight)" be deleted from page 4, line 37. In order to advance prosecution, the applicants have amended the specification according to the Examiner's suggestion, thus obviating the objection.

Claim Rejections- 35 U.S.C. §103

The Examiner rejected claims 1, 3, 4, 6, 7, 9, 11 and 12 under 35 U.S.C. §103(a) as obvious over Maruoka et al. (US 5,252,395) in view of Spada et al. (US 6,293,037) and McLaughlin et al. (US 6,365,793); claims 8 and 16 under 35 U.S.C. §103(a) as obvious over Maruoka in view of Spada and McLaughlin, and further in view of Massow et al. (US 5,194,455); claims 5 and 13-15 as obvious over Maruoka in view of Spada and McLaughlin and further in view of Khieu (WO 98/24978); and claim 10 as obvious in view of Maruoka in view of Spada and McLaughlin and further in view of Everaerts et al. (US 5,612,136). The applicants respectfully traverse these rejections.

The applicants again submit that a *prima facie* case of obvious cannot be established against the presently claimed invention because at the time of the invention, a

skilled artisan could not have reasonably expected that the specifically claimed crosslinker would have worked with the specifically claimed polymer in order to produce a satisfactory pressure sensitive adhesive (PSA). This is because at the time of the invention, it was well understood in the art that, in order to achieve sufficiently homogenous crosslink, the polarity of the crosslinker and the polymer should match. Thus, a polar crosslinker should be used with a polar polymer, or an apolar crosslinker should be used with an apolar polymer.

The PSA of the presently claimed invention is apolar due to the amount of isobornyl acrylate in the composition, while the crosslinker, aluminum (III) acetylacetonate, is polar. At the time of the invention, a skilled artisan would not have expected the claimed combination of polymer and crosslinker to achieve sufficient miscibility, which would lead to an insufficient crosslink and poor adhesive properties. In particular, the *expectation* was that the resulting adhesive would exhibit an increase in the wetting surface, and exhibit permanent adhesive and unsuitable for removability. In short, the expectation of the skilled artisan at the time of the invention was that the adhesive would not be good as a removable adhesive.

Surprisingly, however, a very polar thermal crosslinker, aluminum (III) acetylacetonate, achieved excellent miscibility in the apolar polymer composition of the present invention. Moreover, the polarity of the resulting adhesive did not increase to a level that would have caused unsatisfactory adhesion, which would defeat the entire purpose of a removable adhesive.

In response to the foregoing remarks, which were first presented in the applicant's reply dated December 10, 2009, the Examiner stated that the arguments were not persuasive because they were presented without any factual evidence on the record in the form of a suitable affidavit or declaration. In support of the foregoing arguments, the applicants submit herewith a declaration under 37 C.F.R. §1.132 from inventor Dr. Marc Husemann, declaring that, at the time of the invention, there was no reasonable expectation that the presently

claimed adhesive would have exhibited sufficient adhesion properties, especially with regard to removability.

The Examiner also stated that “[g]iven that Maruoka and McLaughlin both generally disclose acrylic based adhesives and that Maruoka is open to a crosslinking agent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add aluminum (III) acetylacetonate crosslinker as taught by McLaughlin in the acrylic PSA of Maruoka as modified by Spada, motivated by the desire to provide PSA with suitable cohesiveness, and given that Maruoka desires crosslinkers”. (Office Action, page 11, paragraph 38). First, the applicants again submit that, for the reasons stated hereinabove and affirmed in the enclosed declaration, that a skilled artisan would *not* have had any reasonable expectation of success. There is nothing in the cited references, including Maruoka or McLaughlin, that contradicts the applicant’s assertion that, at the time of the invention, the combination of an apolar polymer with a polar crosslinker, was not expected to produce an adhesive with suitable removability. Therefore, even though Maruoka is “open to crosslinkers”, as asserted by the Examiner, this still does not equate to a reasonable expectation that the *specifically* claimed combination would have yielded a predictable result.

Moreover, the applicants respectfully remind the Examiner that Maruoka must be further modified to add isobornyl acrylate in order to achieve the present invention. Maruoka’s teaching of being “open to crosslinkers” can be considered only with regard to Maruoka’s adhesive, *not* with regard to adhesive does not even exist in the prior art except in the Examiner’s proposed modification in view of Spada. Accordingly, the applicants again submit that there is nothing in the cited references that would provide a skilled artisan any reasonable expectation that the claimed combination would yield a predictable adhesive.

Based on the foregoing, the applicants respectfully request that the Examiner withdraw these rejections. Applicants believe that the claims are in condition for allowance, and such favorable action is respectfully requested. If any issues remain, the resolution of which may be advanced through a telephone conference, the Examiner is invited to contact the applicants' attorney at the phone number listed below.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263

Respectfully submitted,
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